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Paper No. 6

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In re Application of :
Bakly :
Application No. 10/036,167 :
Filed: January 4, 2002 :
For: METHOD FOR APPLYING :
RETROREFLECTIVE TARGET TO A :
SURFACE :

OFFICE OF PETITIONS
ON PETITION

This is a decision on the renewed petition under 37 CFR 1.183, filed July 11, 2002, requesting waiver of the rules, and that the application be accorded a filing date of November 10, 2001.

The petition is **DISMISSED**.

In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate the existence of an extraordinary situation where justice requires waiver of one or more federal regulations. It is the responsibility of the Commissioner to determine the definitions of the terms "extraordinary" and "as justice requires" as the terms are used in 37 CFR 1.183.¹

In determining when waiver is appropriate, the Office *may* consider the circumstances when courts have exercised their equitable powers to waive requirements of a statute or regulation on behalf of a party. Courts, in determining when waiver is proper, have required due diligence and have required more than a "garden variety claim of excusable neglect."² The Federal Circuit has stated, "Equitable powers . . . should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence."³ Factors which may not justify tolling include: pro se

¹ See Bowles, Price Administrator v. Seminole Rock & Sand Co., 325 U.S. 410, 413-414, 89 L. Ed. 1700, 1702, 65 S. Ct. 1215, 1217 (1945) ("Since this involves the interpretation of an administrative regulation a court must necessarily look to the administrative construction of the regulation if the meaning of the words used is in doubt. . . . [T]he ultimate criterion is the administrative interpretation, which becomes of controlling weight unless it is plainly erroneous or inconsistent with the regulation.")

² See Wiggins v. State Farm Fire and Casualty Co., 153 F. Supp. 2d 16, 21 (D. D.C. 2001) ("A court can equitably toll the statute of limitations . . . plaintiff will not be allowed extra time to file unless he has exercised due diligence, and the plaintiff's excuse must be more than a 'garden variety claim of excusable neglect.'") (citations omitted).

³ U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983) (citations omitted) ("Lockheed had several means at its disposal which it could have employed to guarantee compliance with the regulation, yet it neglected to use any of them. Equitable powers . . . should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence."); See also: Grymes v. Sanders et al., 93 U.S. 55, 61; 23 L. Ed. 798, 801 (1876) ("Mistake, to be available in equity, must not have arisen from negligence. . . . The party complaining must have exercised at least the degree of diligence 'which may be fairly expected from a reasonable person.'") (citing Kerr on Fraud and Mistake, 407); Garcia v. Office of Personnel Management, 2001 U.S. App. LEXIS 21616, 6 (Fed. Cir. 2001) ("Equity will not intervene, however, to protect a claimant from his or her own failure to exercise due diligence in preserving their legal rights.") (citing Irwin v. Department of Veterans Affairs, 498 U.S. 89, 95 (1990)); Goetz & Goetz v. Secretary of Health and Human Services, 2001 U.S. App. LEXIS 943, 5 (Fed. Cir. 2001) ("the special master's finding of a lack of due diligence was not arbitrary, capricious,

status, illiteracy, deafness, lack of legal training, lack of knowledge of the law, lack of knowledge of a legal process, and lack of legal representation.⁴ An attorney's lack of knowledge, misinterpretation of a law, miscalculation of a time period, and failure to exercise due care and diligence will not justify waiver.⁵

Petitioner has failed to establish that petitioner exercised reasonable, due care and diligence. A reasonable person acting with due care and diligence would have filed the application in compliance with 37 CFR 1.10 to ensure its timely filing in the PTO, as well as preserve adequate evidence of such filing.⁶ Petitioner failed to file the application in compliance with 37 CFR 1.10. Petitioner's failure to file the application in compliance with the requirements of 37 CFR 1.10, is simply not an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183.⁷ Petitioner states that mail normally takes 5 days or less to reach the Patent Office from his location. However, the United States Postal Service occasionally has mail delayed and/or lost. A reasonable and prudent person treating the patent as his most important business would not have risked loss or delay, but would have mailed the application in compliance with 37 CFR 1.10.

Even if waiver of the rule would be appropriate if the application had been mailed on October 31, 2001, petitioner has failed to prove that the application was actually deposited on October 31, 2001,

or an abuse of discretion, and precludes the application of equitable tolling.") (*citing Baldwin County Welcome Ctr. V. Brown*, 466 U.S. 147, 151, 80 L. Ed. 2d 196, 104 S. Ct. 1723 (1984) which states, "One who fails to act diligently cannot invoke equitable principles to excuse their lack of diligence.")

⁴ See *Felder v. Johnson*, 204 F.3d 168 171-172 (5th Cir. 2000) (Pro se status is not "rare and exceptional" circumstance, but is typical of those bringing a 28 U.S.C. § 2254 claim. "Mere ignorance of the law or lack of knowledge of filing deadlines does not justify equitable tolling or other exceptions to a law's requirements.") (*citing United States v. Flores*, 981 F.2d 231, 236 (5th Cir. 1993) as "holding pro se status, illiteracy, deafness, and lack of legal training are not external factors excusing abuse of the writ."); *citing Barrow v. New Orleans S.S. Ass'n*, 932 F.2d 473, 478 (5th Cir. 1991) as "holding equitable tolling . . . within the Age Discrimination in Employment Act not warranted by plaintiff's unfamiliarity with legal process, his lack of representation, or his ignorance of his legal rights.", (other citations omitted)).

⁵ See *Harris v. Hutchinson*, 209 F.3d 325, 330-331 (4th Cir. 2000) (Plaintiff argues that he relied on "negligent and erroneous advice" of his attorney. Attorney agrees his advice was erroneous. The court holds, "[A] mistake by a party's counsel in interpreting a statute of limitations does not present the extraordinary circumstance beyond the party's control where equity should step in to give the party the benefit of his erroneous understanding.") (*citing Taliani v. Chrans*, 189 F.3d 597, 598 (7th Cir. 1999) as "holding that a lawyer's miscalculation of a limitations period is not a valid basis for equitable tolling."); *citing Sandvik v. United States*, 177 F.3d 1269, 1272 (11th Cir. 1999) (per curiam) as "refusing to toll the limitations period where the prisoner's delay was assertedly the result of a lawyer's decision to mail the petition by ordinary mail rather than to use some form of expedited delivery."; *citing Gilbert v. Secretary of Health and Human Services*, 51 F.3d 254, 257 (Fed. Cir. 1995) as "holding that a lawyer's mistake is not a valid basis for equitable tolling."; other citations omitted.)

⁶ "The procedures set out in the PTO's regulations are designed to provide the type of direct evidence needed to prove when and to where a lost amendment [or other paper] was sent. Had plaintiff's counsel followed these procedures, as a 'prudent and careful man' would have done in conducting 'his most important business,' then he would have been able to provide sufficient evidence to support a showing of unavoidable delay." *Krahn v. Commissioner of Patents and Trademarks*, 15 U.S.P.Q.2d (BNA) 1823 (E.D. Va. 1990).

⁷ See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce Express Mail customer receipt or any other evidence that application was actually deposited with USPS as Express Mail), *aff'd without opinion*, 95 F.3d 1166 (Fed. Cir. 1996); *Nitto Chemical Industry Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183); *Vincent v. Mossinghoff*, 230 USPQ 621 (D.D.C. 1985) (Misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Action); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978) (Since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

or prior to November 10, 2001. Declarations alone, without corroborating evidence, are normally insufficient to establish a filing date.⁸ Petitioner's assertion that the above-identified application was deposited on October 31, 2001, is not corroborated by any evidence outside the office of submitting counsel.⁹

It was the availability of an Express Mail label/receipt dated by a disinterested third party (a USPS employee) which persuaded the Commissioner to adopt the use of Express Mail service as the vehicle to implement the authority granted the Commissioner by 35 U.S.C. 21(a). In adopting the Express Mail procedure, the Commissioner specifically rejected the idea of using self serving statements by the applicant or applicant's agent as a means of establishing the date of deposit of a paper or fee with the USPS.

Thus, only the most extraordinary circumstances will justify reliance on a patent applicant's self serving statement, as opposed to an Express Mail receipt, as the means to establish a date of mailing for the purpose of according a filing date to an application for patent. Extraordinary circumstances include when the date-in entered by an USPS employee is illegible or the employee fails to enter a date-in on the label. In both of these instances, an error by the USPS is evident from the receipt itself.¹⁰

Petitioner has failed to prove that the application was deposited on October 31, 2001, or to prove that the application was deposited prior to November 10, 2001. Petitioner's only evidence that the application was filed on or prior to November 10, 2001, is a statement by petitioner.

Even if petitioner could prove the application was mailed on or before November 10, 2001, petitioner failed to act with due care and diligence by failing to mail the application in compliance with 37 CFR 1.10. Therefore, justice does not require waiver of 37 CFR 1.10.

⁸ *Federal Register* at 48 Fed. Reg. 2696 (January 20, 1983), and in the Patent and Trademark Office *Official Gazette* at 1027 Off. Gaz. Pat. Office 9 (February 1, 1983) ("Comment: One person commented that he found the idea of using a declaration or affidavit to establish a date of deposit unacceptable because it exposes the integrity of the assignment of filing dates to the risk of deception. Reply: The use of declarations or affidavits is usually intended to help explain activities which can be supported by exhibits. For example, if the Office copy of the mailing label was not entirely readable, applicant's copy of the "Express Mail" mailing label could accompany a declaration and serve as the basis for granting a filing date.")

Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) ("Plaintiff thereafter submitted three affidavits, a declaration, and copies of two pages of records from his attorney's law firm, but the Commissioner finally denied plaintiff's petition for a filing date on the grounds that, if plaintiff had used Express Mail properly, he would have had an Express Mail receipt showing the actual date of mailing; and that the materials later submitted by the plaintiff were not good enough proof.

The materials plaintiff gathered together included a photocopy copy of an Express Mail label that is undated and bears no evidence of any U.S. Postal Service handling. Nothing submitted by plaintiff to the Patent and Trademark Office is corroborated by anything outside the office of the submitting counsel. It was the view of the Commissioner of Patent and Trademarks that these circumstances did not establish the extraordinary conditions that might warrant a waiver.

The decision was for the Commissioner to make, and I cannot find on the basis of the record presented to me that the Commissioner's decision was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law."), aff'd without opinion, 95 F.3d 1166 (Fed. Cir.1996).

⁹ See Honigsbaum v. Lehman, 903 F. Supp. 8, 10 (D.D.C. 1995);

¹⁰ Another circumstance is when petitioner alleges that the date-in was incorrectly entered. In such a situation, the Office will accept information from the USPS which indicates the date-in is incorrect and will accept evidence from petitioner created within one business day of deposit of the envelope with the USPS. In implementing 35 USC § 21, and determining the breadth of 37 CFR 1.10, the Office chose to require corroboration from outside the party's control except for business records created within one business day of deposit. Declarations or affidavits by the individuals who prepared the application for filing and deposited the application in Express Mail service have been accepted to show the actual date of mailing, if properly supported by exhibits.

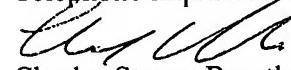
Since the petition lacks a showing that the application was deposited on or before November 10, 2001, the petition under 37 CFR 1.183 is subject to dismissal. Since the petition lacks a showing that this is an extraordinary situation in which "justice requires" suspension of the rules, the petition under 37 CFR 1.183 is subject to dismissal.

Conclusion:

Congress, through 35 USC 21, chose to allow the Commissioner, at his discretion, to create rules which would allow the filing date to be the date of deposit with the USPS, rather than the date of receipt by the Patent and Trademark Office. The Commissioner had the responsibility of deciding exactly what group of applications would be accorded a filing date as of the date of receipt by the Office and which group would be given a filing date as of the date of deposit with the USPS. The Commissioner chose to allow the second group to only be comprised of applications mailed in compliance with 37 CFR 1.10. The purpose of 37 CFR 1.183 is to deal with extraordinary circumstances where justice requires waiver of a rule, not to expand the size of the second group by circumventing 37 CFR 1.10. Petitioner has failed to establish that this is an extraordinary situation where justice requires waiver of the rule.

The file is now being forwarded to Technology Center 1700 for examination in due course.

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